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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,383	07/24/2003	James L. Kroening	P1905US00	9803

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EXAMINER

PATEL, KAUSHIKKUMAR M

ART UNIT

PAPER NUMBER

2188

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/626,383	KROENING, JAMES L.	
	Examiner	Art Unit	
	Kaushikkumar Patel	2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 9 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the Applicant's communication filed on January 10, 2007 in response to PTO Office Action mailed October 10, 2006. The Applicant's remarks and amendments to the claims and/or the specification were considered with the results that follow.
2. In response to the last Office Action, claims 7-12 and 22 have been amended. No claims have been added. No claims have been canceled. As a result, claims 1-22 remain pending in this application.
3. The rejection of claims under 35 U.S.C. 112, 2nd paragraph has been withdrawn due to amendments filed on January 10, 2007.

Response to Arguments

4. Applicant's arguments with respect to claims 1-22 have been fully considered but they are not persuasive.
5. Applicant argues that Kawano (US 2003/0229768 A1) inherently teaches features of claims 1 and 8 on page 10 of remarks filed on January 10, 2007. Examiner respectfully disagrees with that because nowhere in previous office action it is stated that Kawano inherently teaches all features of claims 1 or 8. Applicant further argues that Kawano teaches data is passed from protected area to user area when software in user area becomes unstable (remarks, page 9). Examiner respectfully disagrees with this, as per Kawano, par. [0016], "a still further embodiment of the invention may include

a communication providing means for providing communication between the first module and second module in the saving/management means in passing (copying, saving) the user data between the first partition and the second partition", it is apparently clear from above passage of Kawano that data can be transferred any time between the partitions and the teaching is not limited to passing data when user area becomes unstable as applicant argues. The examiner also would like to mention that, USPTO personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure [*In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)] and limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs, Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). The claim 1, as recited "copying contents of ..." nowhere claims when the data is copied from protected area and thus

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Kawano clearly teaches copying of contents of protected area to user area. Applicant further argues that Kawano does not teach copying user area to another location. Examiner agrees with that and to complement deficiencies of Kawano, APA was introduced. APA teaches advantages of having backup copies of data stored on different locations (APA, page 2). Thus, the combination of Kawano and APA teaches limitations of claim 1, because one having ordinary skill in the art can use the method of Kawano to pass (copy or save or transfer) data between the partitions and use teachings of APA to copy user data to different location. As per claim 7, the claim recites restoring data from different location to hard disk and then to protected area. APA clearly teaches restoring data to user area (because protected area is not accessible) and one having ordinary skill in the art can use Kawano's teaching to backup information stored in the user area to protected area of hard disk (Kawano, par. "in backing up the user data, the file produced by the user mode module is copied to the PARTIES partition") for immediate recovery.

6. Thus, the rejections of claims are maintained and reiterated below for applicant's convenience. Also rejection of claims 7-12 under 35 U.S.C. 101 is also maintained because as amended "signal bearing storage medium" is not defined in the specification and such storage medium is not known in the art.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 7-12 are not limited to tangible embodiments. In view of applicant's disclosure, specification page 8, lines 8-9, the signal bearing medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g. read-only memory device, CD-ROM etc.) and intangible embodiments (e.g. communication medium and telephone networks etc). As such, the claims are not limited to statutory subject matter and are therefore non-statutory. Suggested correction would be, "computer/machine readable storage medium".

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5, 17-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al. (US 2003/0229768) (Kawano herein after) and further in view of Applicant's Admitted Prior Art (APA herein after).

As per claim 1, Kawano teaches a method:

Copying contents of a protected area of a first storage device to a user area of the first storage device (taught as storage device having two partitions (paragraph [0033]) and the user data is backed up to the PARTIES partition and retrieved the data

back to user partition (paragraph [0039]) thus, Kawano inherently teaches contents of the protected area are copied to the user area of the storage device).

Kawano fails to teach saving user area to a second storage device. But as per APA users backup their storage devices (first storage device) to backup storage devices (specification page 2, lines 24-25). It would have obvious to one having ordinary skill in the art at the time of invention to have backed up the user partition data to second storage device so that data can be retrieved in case of damage (such as by fire, water etc.) to the first storage device (specification page 2, lines 19-25).

As per claim 2, Kawano teaches the program, which causes the computer to execute the accessing function (paragraph [0020]). Kawano also teaches that the program can be distributed (downloaded) via a network (paragraph [0021]).

As per claims 3 and 4, APA teaches that the user area of the storage devices are saved to the second storage devices directly connected to electronic device or indirectly connected, e.g. attached to the backup server (specification page 2, lines 25-26).

As per claim 5, Kawano teaches that booting to protected area and administering the user data (paragraph [0033]).

As per claim 6, As per APA the protected areas are not accessible by the operating system (specification page 2, lines 30-32). It would have been obvious to one having ordinary skill in the art at the time of the invention have booted back to user partition to have access to operating system residing in the user area to back up the data stored in the user area because the save and restore functions are performed by the operating system residing in the user area.

Claims 17 and 21 are rejected under same rationale as applied to claims 1 and 2 above. Claim 1, as taught by Kawano and APA above copies the protected area to user and backing up the user area to another storage device directly or indirectly attached to the electronic device, and claim 2 teaches downloading utility software from network or server.

Claim 18 and 19 are rejected under same rationale as per claims 4-6 above.

As per claim 22, Kawano teaches transferring second contents (data from HPA) form HPA to user area (paragraphs [0016] and [0044]). And as per claim 1, APA teaches backing up first contents (data from user space) and second contents to secondary storage space.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (APA herein after) and further in view of Kawano et al. (US 2003/0229768) (Kawano herein after).

As per claim 7, APA teaches saved contents can be restored to the electronic device (e.g. data can be restored from back up storage (first storage) to the storage connected to the device (second storage) (page 2, lines 27-28) and also as per APA

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operating system is unable to access the HPA, it inherently teaches restoring the data in user space of the second (attached to device) storage).

APA fails to teach copying protected area directory (data) from the user space of second storage to protected area of the second storage. Kawano teaches the data in the user area is copied to protected area (paragraph [0039]). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the restoring method of APA by the teachings of Kawano so that the data can be protected from viruses and system can be recovered without using removable disks or storage devices (paragraph [0008]).

As per claim 8, APA inherently teaches saving of data from second (attached to the electronic device) storage to the first storage (attached to the back up server) before restoring. Because one having ordinary skill in the art at the time of invention would know that data can be restored from back up storage device if data was backed up from second storage to first storage (back up storage) initially.

Claims 10-12 are rejected under the same rationale as applied to claims 5,6 and 2 as above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al. (US 2003/0229768) (Kawano herein after) and further in view of Applicant's Admitted Prior Art (APA herein after) (and Stevens (US 6,779,109 B2) presented as an evidentiary reference).

As per claim 13, Kawano teaches an electronic device (fig. 1, par. [0031], taught as computer system) comprising:

a processor (inherent in computer system); an a storage device (fig. 1, item 11), wherein the storage device comprises instructions, which when executed on the processor (par. [0029] and [0030]) comprise:

booting to the protected area and copying contents of the protected area to a user area of the storage device (par. [0042], taught as BIOS boots the special operating system from PARTIES partition and par. [0016], user data is passed between partitions).

Kawano fails to teach, determining whether the storage device includes a protected area and saving user area to a backup storage device. But as per APA users backup their storage devices (first storage device) to backup storage devices (specification page 2, lines 24-25). It would have obvious to one having ordinary skill in the art at the time of invention to have backed up the user partition data to second storage device so that data can be retrieved in case of damage to the first storage device (specification page 2, lines 19-25).

APA teaches that some storage device contains a protected area (specification page 2, lines 30-31). It would have been obvious to one having ordinary skill in the art at

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the time of the invention implemented a process to check whether the storage device includes a protected area before trying to boot from PARTIES partition because all storage devices do not include protected area (APA, page 2, lines 30-31, checking whether a protected area is present on a storage device is known in the art as taught by Stevens. See abstract).

As per claim 14, Kawano teaches rebooting to user area after user data is restored from PARTIES partition (par. [0043]).

As per claim 15, APA teaches backup storage device (specification page 2, lines 24-25).

As per claim 16, Kawano teaches storing software modules on different storage devices or on network system (par. [0030]). It would have been obvious to one having ordinary skill in the art at the time of the invention to download software from different storage device (network) to be executed by computer system to achieve the functionality of Kawano.

Allowable Subject Matter

15. Claims 9 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and by overcoming rejection under 35 U.S.C. 101 non-statutory subject matter.

16. The following is a statement of reasons for the indication of allowable subject matter:

As per dependent claims 9 and 20, APA or Kawano fail to teach creating the protected area (claim 9) as well as create utility (claim 20) on the storage device attached to the electronic device before backing up the data from the back up storage device.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaushikkumar Patel whose telephone number is 571-272-5536. The examiner can normally be reached on 8.00 am - 4.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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kmp

Kaushikkumar Patel
Examiner
Art Unit 2188



HYUNG SONG
SUPERVISORY PATENT EXAMINER

3-16-07